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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,129	07/05/2000	Galen Rasche	LE9-00-051	4624

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EXAMINER

POON, KING Y

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,129

Applicant(s)

RASCHE ET AL.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. In view of applicant's argument presented in the appeal brief filed on 10/29/2002, and newly found prior art, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Colbert et al. (U.S. Patent # 5,699,494)

Regarding claim 15: Colbert et al. teach a method for diagnosing a printer, (abstract, column 2, lines 25-35) the method comprising the steps of: a) obtaining a stand-alone printer; (16, fig. 1) b) establishing a communication link (21, fig. 1) between the stand-alone printer and a computer; (11, fig. 1) and c) transmitting instructions (commands, request, column 11, lines 5-7) over the communication link from the computer to the stand-alone printer; and d) diagnosing (obtaining needed information from function, column 11, lines 14-15) one or more functions of the stand-alone printer in accordance with the transmitted instructions. (Column 11, lines 1-15)

Regarding claim 16: Colbert et al. teach wherein the instructions comprise content to be presented on a display of the stand-alone printer. (column 3, lines 65-67, column 4, lines 1-5, abstract)

Regarding claim 17: Colbert et al. teach the computer processing user inputs to the stand-alone printer. (Column 13, lines 15-35, column 10, lines 1-40)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satomi (US 4,759,053) in view of Batten et al. (US 6,417,937).

Regarding claim 1: Satomi teaches a printer configuration, (fig. 1) comprising: a) a computer readable medium (memory 6, fig. 1, column 2, line 45) comprising data; b) a computer (host computer 4, fig. 1, column 1, line 68, column 2, line 1) having access to the data on the computer readable medium (column 3, lines 1-10); c) a communication link (modem 18, fig. 1) connected to the computer; d) a printer (terminal equipment, column 1, lines 65-69, 1, fig. 1, terminal equipment is a printer because it can print, column 3, lines 10-15) connected to the communication link (fig. 1) and in communication with the computer, (column 2, lines 64-69, column 3, line 1-10) the printer having a selection mechanism (keys 8, column 2, lines 65) and having access to the data over the communication link in response to a user's input (column 2, lines 64-69, column 3, lines 1-15) to the selection mechanism on the printer.

Satomi also teaches that the terminal equipment comprises a facsimile equipment component for: reading a picture, (column 2, lines 10-16), transmitting the read picture to a computer, (column 2, lines 49-55), and receiving the transmitted read picture from the computer for printing (column 2, lines 64-69, column 3, lines 1-15)

Satomi does not teach the printer is a photocopier. (Print image of a photograph)

Yoo, in the same art of receiving and printing images from a printer, teaches a facsimile equipment/machine inherently print image of a photograph (column 1, lines 14-30) by using the

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reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signal suitable for storing, displaying, processing by a computer, transmitting and printing.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi to include: reading a photograph, transmitting the read photograph to the computer, and receiving the transmitted read photograph from the computer for printing.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi by the teaching of Yoo because of the following reasons: (a) using the printer to print photograph image would have provided an extra benefit for users using the printer without adding cost to users and thereby, increased the desire of users to purchase the printer; and (b) it would have simplified the printing needs of users by providing users with a printer that would print a document as well as photograph instead of using a printer to print the document and another printer to print the photograph.

Regarding claim 2: Satomi teaches a user interface (keyboard with a display, column 4, lines 19-21) on the photoprinter having a plurality of options selectable by a user with the selection mechanism. (Column 3, lines 35-40)

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Regarding claim 3: Satomi teaches wherein the options include downloading files from the computer, (accessing and transmitting desired data from computer, column 3, lines 35-40), uploading files to the computer, (column 3, lines 50-69), or printing files (column 3, line 1-15)

Regarding claim 4: Satomi teaches wherein the one or more files (desired data, column 3, lines 35-40) are presented on the user interface. (Column 4, lines 19-23, desired data are data communicates from the computer to the facsimile equipment. Therefore, desired data are contents of communications)

Regarding claim 5: Satomi teaches wherein the data comprises digital (binary signals, column 2, lines 13-14) photographs. (See discussion of claim 1)

Regarding claim 6: Satomi teaches wherein the data comprises executable code (column 2, lines 15-25) for running on the photoprinter.

Regarding claim 9: Satomi teaches wherein the computer is a server. (The computer (host, column 2, lines 64-69) is responding to a command from the client (terminal equipment, column 2, lines 64-69)

Regarding claim 11: Satomi teaches a printer configuration, (fig. 1) comprising: a) a computer (host computer 4, fig. 1, column 1, line 68, column 2, line 1) having a plurality of digital (binary signals, column 2, line 13, column 2, lines 50-55) pictures on a computer readable medium (memory 6, fig. 6, column 2, line 45); b) a communication link (modem 18, fig. 1) connected to the computer; and c) a printer (terminal equipment, column 1, lines 65-69, 1 of fig. 1) connected

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to the computer via the communication link, the printer having means (keys 8, column 2, line 65) for accessing (column 2, lines 64-69, column 3, lines 1-15) the digital picture.

Satomi also teaches that the terminal equipment comprises a facsimile equipment component for: reading a picture, (column 2, lines 10-16), transmitting the read picture to a computer, (column 2, lines 49-55), and receiving the transmitted read picture from the computer for printing (column 2, lines 64-69, column 3, lines 1-15).

Satomi does not teach the printer is a photoprinter, (Print image of a photograph) and the pictures are photographs.

Yoo, in the same art of receiving and printing images from a printer, teaches a facsimile equipment/machine inherently print image of a photograph (column 1, lines 14-30) by using the reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signal suitable for storing, displaying, processing by a computer, transmitting and printing.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi to include: reading a photograph, transmitting the read digital photograph to the computer, and receiving the transmitted read digital photograph from the computer for printing.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi by the teaching of Yoo because of the following reasons: (a) using the printer to print photograph image

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would have provided an extra benefit for users using the printer without adding cost to users and thereby, increased the desire of users to purchase the printer; and (b) it would have simplified the printing needs of users by providing users with a printer that would print a document as well as photograph instead of using a printer to print the document and another printer to print the photograph.

Regarding claim 12: Satomi teaches a method for accessing digital pictures, (column 2, lines 64-69, column 3, lines 1-15) the method comprising the steps of: a) placing one or more digital (binary signals, column 2, lines 13-14) pictures on a computer (column 2, lines 50-55); b) establishing a communication link (column 3, lines 54-65) between a photoprinter and the computer; c) inputting a request (column 3, lines 35-40) to the printer by a user (the person who is entering command using keys, column 3, lines 35-40); and d) accessing the digital pictures (column 2, lines 64-69, column 3, lines 1-15) by the printer in response to the request.

Satomi also teaches that the terminal equipment comprises a facsimile equipment component for: reading a picture, (column 2, lines 10-16), transmitting the read picture to a computer, (column 2, lines 49-55), and receiving the transmitted read picture from the computer for printing (column 2, lines 64-69, column 3, lines 1-15)

Satomi does not teach the printer is a photoprinter, (Print image of a photograph) and the pictures are photographs.

Yoo, in the same art of receiving and printing images from a printer, teaches a facsimile equipment/machine inherently print image of a photograph (column 1, lines 14-30) by using the

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reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signal suitable for storing, displaying, processing by a computer, transmitting and printing.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi to include: reading a photograph, transmitting the read digital photograph to the computer, and receiving the transmitted read digital photograph from the computer for printing.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi by the teaching of Yoo because of the following reasons: (a) using the printer to print photograph image would have provided an extra benefit for users using the printer without adding cost to users and thereby, increased the desire of users to purchase the printer; and (b) it would have simplified the printing needs of users by providing users with a printer that would print a document as well as photograph instead of using a printer to print the document and another printer to print the photograph.

Regarding claim 13: Satomi teaches wherein the step of accessing comprises downloading the digital photographs (accessing and transmitting desired data from computer, column 3, lines 35-40).

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6. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over as applied to claim 1 above, and further in view of Foth (US 6,473,498).

Regarding claim 7: Satomi does not teach wherein the computer is connected locally to the photoprinter.

Foth, in the same area of connecting a facsimile machine to a computer, teaches wherein a computer is connected locally to a facsimile machine by using an RS232 cable. (Column 1, lines 50-65)

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi/Yoo's photoprinter to include: the computer is connected locally to the facsimile machine of the photoprinter.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi/Yoo's photoprinter by the teaching of Foth because of the following reasons: (a) it would have reduced the cost of using multiple phone lines for connecting the computers and printers in a small business environment as taught by Foth at column 1, lines 30-40; and (b) it would have reduced to use of phone lines as taught by Foth at column 1, lines 35-40.

Response to Arguments

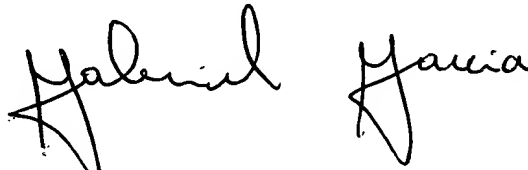
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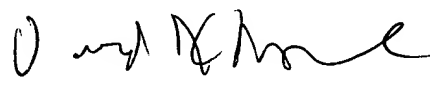
7. Applicant's arguments with respect to claims 1-7, 9, 11-13, 15-17 have been considered but are moot in view of the new ground(s) of rejection. Please see office action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892

January 27, 2003


GABRIEL GARCIA
PRIMARY EXAMINER


DAVID MOORE
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